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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO.       |
|---|-------------|----------------------|------------------------------|------------------------|
| 10/624,002  | 07/21/2003  | Hideobu Mikami       | 1007-020                     | 5624                   |
| 47888   | 7590        | 11/08/2007           |                              |                        |
| HEDMAN & COSTIGAN P.C.<br>1185 AVENUE OF THE AMERICAS<br>NEW YORK, NY 10036 |             |                      | EXAMINER<br>GOLOBOY, JAMES C |                        |
|   |             |                      | ART UNIT<br>1797             | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>11/08/2007      | DELIVERY MODE<br>PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/624,002 | <b>Applicant(s)</b><br>MIKAMI ET AL. |  |
|                              | <b>Examiner</b><br>James Goloboy     | <b>Art Unit</b><br>1797              |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,7 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 7, 11-14 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's amendment filed 10/5/07 overcomes the rejection under 35 USC 112 set forth in the office action mailed 6/5/07. The amendment does not overcome the rejection under 35 USC 103, which has been maintained below.

### ***Claim Objections***

2. Claim 14 is objected to because of the following informalities: In the first line of page 4 of the claims, "alkyldipheny;" should be "alkyldiphenyl". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

3. Claim 1, 3, 7, and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokouchi in view of Birke.

This rejection is adequately set forth in paragraph 5 of the office action mailed 6/5/07, which is incorporated here by reference.

### ***Response to Arguments***

4. Applicant's arguments filed 10/5/07 have been fully considered but they are not persuasive. Applicant argues that the amended claims are not rendered obvious by Yokouchi and Birke for the following reasons:

i) Yokouchi teaches away from the use of a grease containing only ether oil as the base oil, and does not teach sodium sebacate.

ii) Birke "merely mentions that sodium sebacate could be used as an additive", and does not provide guidance as to how much is to be used

iii) The examples in the specification and data in the declaration dated 4/11/07 demonstrate that the claimed composition gives unexpectedly superior results.

With respect to i), it is noted that the claims do not require the base oil to consist solely of ether oil, nor do they exclude the presence of ester oil. As noted in the rejection in paragraph 5 of the office action mailed 6/5/07, Yokouchi discloses in both the text and the inventive examples base oil compositions comprising at least 20% by weight of alkyldiphenyl ether. As for sodium sebacate, Yokouchi teaches that the composition can contain further known additives, including rust preventives. Anticorrosion agents are rust preventives, and Birke teaches the specific anticorrosion agent sodium sebacate.

With respect to ii), Birke teaches that sodium sebacate is a useful anticorrosion additive for urea-thickened grease used to lubricate bearings, such as the grease of Yokouchi. One of ordinary skill in the art therefore would have been motivated to use the sodium sebacate of Birke as a rust preventive in the composition of Yokouchi, and had a reasonable expectation of success in doing so.

With respect to iii), applicant's argument regarding unexpected results has been addressed in the office action mailed 6/5/07. While the claims have been amended to limit the metal salt of a dibasic acid to sodium sebacate, all the sample compositions

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exhibiting alleged unexpected results contain 1% by weight of sodium sebacate, and are therefore not commensurate with the scope of the claims which recite a concentration of 0.5 to 5% by weight. It is further noted that the claims recite a base oil containing at least 20% by weight of alkyldiphenyl ether oil, but the base oil in all the examples contains at least 80% by weight of the alkyldiphenyl ether oil. Similarly, all the examples contain 20% by weight of a specific thickener, while claim 1 recites a range of 5 to 30% by weight of a broader class of thickeners.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*James C. Calabro*  
JCG

  
Glenn Caldarola  
Supervisory Patent Examiner  
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